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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/926,312      | 10/12/2001  | Jean-Pierre Dubois   | P67228US0           | 9994             |

136 7590 09/08/2005

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| EXAMINER |
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HENDERSON, MARK T

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| ART UNIT | PAPER NUMBER |
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3722

DATE MAILED: 09/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/926,312

Applicant(s)

DUBOIS ET AL.

Examiner

Mark T. Henderson

Art Unit

3722

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

## **DETAILED OFFICE ACTION**

### **Faxing of Responses to Office Actions**

In order to reduce pendency and avoid potential delays, TC 3700 is encouraging FAXing of responses to Office Actions directly into the Group at (571) 273-8300. This practice may be used for filing papers, which require a fee by applicants who authorize charges to a PTO deposit account. Please identify the examiner and art unit at the top of your cover sheet. Papers submitted via FAX into TC 3700 will be promptly forwarded to the examiner.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

1. Claim 1 recites the limitation "the recording function" and "the deactivating means" in line 5. There is insufficient antecedent basis for this limitation in the claim.

Furthermore, it is not understood what is meant by "and fast with the removable member (9)....."

2. Claim 4 recites the limitation "the deactivating means" in line 2. There is insufficient antecedent basis for this limitation in the claim.

3. Claim 5 recites the limitation "the second face" in line 2. There is insufficient antecedent basis for this limitation in the claim.

4. Claim 6 recites the limitation "the protecting film" in line 2. There is insufficient antecedent basis for this limitation in the claim.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-8, as best understood, are rejected under 35 U.S.C. 103(a) as being unpatentable over Crowell (5,577,918) in view of Cea (4,823,489) and further in view of Cooper (5,836,616).

Crowell discloses in Fig. 1, 2, 5, 15, a sound recording and reproduction device (20) comprising a recording means (25, 26, 27, 28) for reproducing recorded sounds; a means (50 as seen in Fig. 5) for fixing the device (20) on a support (75 as shown in Fig. 15, and as stated in Col. 11, lines 5-17), wherein fixation means comprises and adhesive means (Col. 7, lines 42-52)

and is fixed on a second face of a printed circuit board (21, as seen in Fig. 5); wherein the recording means and reproduction means are fixed on a first face of a printed circuit board (see Fig. 1); the recording means comprises a microphone (27) actuated by a button control means (31) and a erasable re-recordable type of memory (25, as stated in Col. 6, lines 7-19); and wherein the reproduction means comprises a loud speaker (28) actuated by a control means (30).

However, Crowell does not disclose wherein the device has a double face adhesive tape with a removable protecting member film; a means for irreversibly deactivating the recording function wherein the deactivating means has a removable element whose removal provokes a rupture of contact.

Cea discloses in Fig. 4, a device (26) comprising a double face adhesive tape (40) with a removable protecting member film (48).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Crowell's device with a fixation means having a double sided tape with a removable protecting film as taught by Cea for providing an alternative adhesive fixation means wherein the device can be fixated to a support if desired.

However, Crowell as modified by Cea does not disclose: a means for irreversibly deactivating the recording function wherein the deactivating means has a removable element whose removal provokes a rupture of contact.

Cooper discloses in Fig. 1, 2, 5 and 6 a device comprising a means (66) for irreversibly deactivating the recording function (64) wherein the deactivating means has a removable element (tear-off tab) and a connected tongue, whose removal provokes a rupture of contact.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Crowell's and Cea's device with a deactivating means for the recording function as taught by Cooper for providing a means in which to permanently make a recording without the recording being erased.

In regards to **Claim 6**, it would have been obvious to place the removable deactivating element at any desired location on the card device, since it has been held that rearranging parts of an invention involves only routine skill in the art. Therefore, it would have been obvious to place the removable deactivating element at any desired location on the device since applicant has not disclosed the criticality of having the deactivating element at a particular location, and would function equally as well at any location.

#### ***Prior Art***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Shimogori et al, Yu, Hornstein et al, Young, Cobb, Manico, Tarlow et al, Doedelein et al, Lamping, Kirschenbaum et al, Arnold et al, Chomette et al, Lemelson et al, Dech et al, and Kondo disclose similar devices.

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**Contact Information**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark T. Henderson whose telephone number is (571) 272-4477, and informal fax number is (571) 273-4477. The examiner can be reached on Monday-Friday from 9:00AM to 3:45PM. If attempts to reach the examiner by telephone are unsuccessful, the Examiner Supervisor, Boyer Ashley, can be reached at (571) 272-4502. The formal fax number for TC 3700 is (571) 273-8300.



MTH

September 6, 2005



BOYER D. ASHLEY  
PRIMARY EXAMINER